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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,059	11/27/2001	Jacques Quellais	216196US-30RE	1287

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EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,059

Applicant(s)

QUELLAIS ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 30 and 31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16, 21-23 and 25-27 is/are allowed.
- 6) ☒ Claim(s) 17-20, 24, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3.5 and</u> . | 6) <input type="checkbox"/> Other: _____. |

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Protest

Applicant has not filed any response to the protest filed 5/24/02. The Examiner is now responding to applicants' amendments and arguments filed 7/12/02 in response to the office action mailed on 6/12/02. The Examiner has considered all of the prior art submitted in the protest and has initialed such on the provided 1449. The Examiner has considered all of the arguments presented in the Protest and such is reflected in the following office action.

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. the sole shown in Figures 1-4,
- II. The sole shown in figures 1, 2, and 5.
- III. The sole shown in figures 1, 2, 7, and 8.
- IV. The sole shown in figures 1, 2, 9, and 10.
- V. The sole shown in figures 1, 2, 10, and 11.
- VI. The sole shown in figures 1, 2, and 12.
- VII. The sole shown in figures 1, 2, and 13.
- VIII. The sole shown in figures 1, 2, and 14.
- IX. The sole shown in figures 1, 2, 15, and 16.
- X. The sole shown in figures 1, 2, and 17.
- XI. The sole shown in figures 1, 2, and 18.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. Newly submitted claims 30 and 31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the invention claimed in claims 30 and 31 do not require the intermediate layer to cover the entire surface of the ground contacting layer as required by the species claimed in original claims 1-27.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30 and 31 are withdrawn from

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consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Reissue Applications

3. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claims 28 and 29 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In an amendment originally filed on 9/2/94 and entered after being refiled on 10/6/94 applicant amended the independent claim which ultimately became patented claim 1 by the addition of the phrase "extending over an entire surface of said ground contact layer". Claim 28 broadens this phrase to "substantially an entire surface" and claim 29

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changes this phrase (resulting in deleting this phrase and replacing it with a broader phrase) to "at least a surface of said ground contact layer which is directly beneath a lateral portion of a heel of a person wearing the sport shoe". The elimination of the limitation of "over the entire surface" results in recapture since this limitations was added to overcome a rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The intermediate layer extending substantially over the entire sole area is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claim recites the function of the intermediate layer "providing both for the distribution of shockwaves and stresses sensed by the ground contacting layer and for their diffusion over said comfort layer". In order for this function to occur, the intermediate layer must extend over a substantial surface of the sole, not merely just over the lateral heel portion. Also, the specification does not provide basis for an intermediate layer located on the "lateral heel" which would function as claimed and therefore the specification is not enabling for the claimed subject matter.

6. Claims 17-20, 24, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17 the phrase "said rigid intermediate layer.....a succession of rigid inserts...", in claim 19 the phrase "...two arc-shaped recesses...", in claim 24 the phrase "which pass through said intermediate layer, or rib...." contradict the limitation of "said intermediate layer extending over an entire surface of said ground contacting layer" as claimed in claim 1 from which these claims depend rendering the claims confusing, vague, and indefinite.

In claim 29 the phrase "providing both for the distribution of shockwaves and stresses sensed by said ground contact layer and for their diffusion over said comfort layer" is functional, indefinite, and incomplete because it contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language. The recitation that "the intermediate layer extends over at least a surface of said ground contact layer which is directly beneath a lateral portion of a heel" is insufficient for the above recited function.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 28 and 29 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Tong (5185943).

Tong shows a shoe comprising a laminated profile sole comprising a ground contacting layer (26 or 118), an upper comfort layer (28 or 116), and an intermediate layer (56 or 120) as claimed.

9. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Barry (5052130).

Barry shows a shoe comprising a laminated sole comprising a ground contacting layer (16), a comfort layer (18), and an intermediate layer (20) which covers "substantially" an entire area of the ground contacting layer as claimed.

Allowable Subject Matter

10. Claims 1-16, 21-23, and 25-27 are allowed.

11. The following is a statement of reasons for the indication of allowable subject matter: Claims 1-16, 21-23, and 25-27 have been indicated as allowable over the above applied references because these references do not show an intermediate layer

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which extends over "an entire surface of said ground contact layer". Claims 1-27 have been indicated as allowable over EP 0373336 because the "intermediate layer" (2) does not provide the recited function of "constituting a framework for the ground contact layer preventing deformation of the ground contact layer...". It appears that the intermediate layer of EP 0373336 would encourage and cause the outersole to deform due to the undulations and the expanding and contracting of such during use.

Response to Arguments

12. Applicant's arguments filed 7/12/02 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the Recapture, these arguments are not persuasive because they do not take into account *Pannu v. Storz* 59 USPQ 2d 1597 which states "On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome the prior art rejections". Applicant has attempted to recapture subject matter because the claims added in the reissue have deleted limitations which were added and argued to overcome the rejections, and therefore applicant surrendered subject matter which is broader than this limitation. It is noted that applicant did present claim language in original application (claim 25) which stated "sole according to claim 1, therein each of said layers constituting the sole extends or does not extend over its entire surface". Applicant canceled this claim in an amendment dated 2/7/94. The limitation of an intermediate layer which extends over less than the entire surface was presented and this limitation was canceled and a narrower limitation was presented and argued to overcome the prior art.

In reference to claim 29, it is noted that the realm of corrections in reissue applications does not include recapturing of surrendered subject matter "in an attempt to custom fit' the reissue claims to a competitor's product" (Pannu v. Storz instruments Inc. 106 F Supp. 2d 1304 at 1309 (July 10, 2000))

In response to applicants' arguments directed towards the rejections under 35 USC 112 first paragraph, there is no disclosure of (and therefore is not enabling) for an intermediate layer on the lateral heel area to provide the functions recited. In order for the intermediate layer to function as claimed, it would have to cover a substantially portion of the ground contacting layer. There is no disclosure contrary to such.

In response to applicants' arguments directed towards the rejections under 35 USC 112 second paragraph, the limitations of the intermediate layer being located on the lateral heel area is insufficient to support the function of the intermediate layer as claimed. There is insufficient structure recited to support the recited function and therefore it is not clear what structural limitations applicant intends to encompass with such language.

In response to applicants' arguments directed towards Tong, Tong clearly shows an intermediate layer which extends into the forefoot area (see figures 16 and 17) and since Tong and/or Barry shows all of the positively recited structures, it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact,

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be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In re Swinehart, 169 USPQ 226 (CCPA1971). Also, it is noted that claim 29 merely requires that the intermediate layer be located at the lateral heel portion and since applicant considers this claim to recite sufficient structure for the recited functions in the claim, any of the intermediate layers disclosed by Tong are considered to meet the functional limitations claimed inasmuch as the claimed structures perform these functions. The intermediate layers of either Tong or Barry are considered to have controlled torsional and flextional rigidity to some degree.

In response to applicants' arguments directed towards Barry, there is no requirement in claim 28 for the intermediate layer to be located under the lateral part of the heel and therefore, these arguments are not persuasive. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. Constant v. Advanced Micro-Devices Inc., 7 USPQ2d 1064. In response to applicants' arguments directed to some sort of minimal test for the phrase "substantially an entire surface", no such minimal test is known or disclosed. Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's


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convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.


Marie Patterson
Primary Examiner
Art Unit 3728